

DETAILED ACTION

The instant application having Application No. 10/589837 filed on 8/18/06 is presented for examination by the examiner.

Priority

Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been received.

Specification

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

The abstract of the disclosure is objected to because it contains references to the figures. Correction is required. See MPEP § 608.01(b).

The written description of the disclosure is objected to because it lacks the proper headings.

Content of Specification

- (a) Title of the Invention: See 37 CFR 1.72(a) and MPEP § 606. The title of the invention should be placed at the top of the first page of the specification unless the title is provided in an application data sheet. The title of the invention should be brief but technically accurate and descriptive, preferably from two to seven words may not contain more than 500 characters.
- (b) Cross-References to Related Applications: See 37 CFR 1.78 and MPEP § 201.11.
- (c) Statement Regarding Federally Sponsored Research and Development: See MPEP § 310.
- (d) The Names Of The Parties To A Joint Research Agreement: See 37 CFR 1.71(g).
- (e) Incorporation-By-Reference Of Material Submitted On a Compact Disc: The specification is required to include an incorporation-by-reference of electronic documents that are to become part of the permanent United States Patent and Trademark Office records in the file of a patent application. See 37 CFR 1.52(e) and MPEP § 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text were permitted as electronic documents on compact discs beginning on September 8, 2000.
- (f) Background of the Invention: See MPEP § 608.01(c). The specification should set forth the Background of the Invention in two parts:
 - (1) Field of the Invention: A statement of the field of art to which the invention pertains. This statement may include a paraphrasing of the applicable U.S. patent classification definitions of the subject matter of the claimed invention. This item may also be titled "Technical Field."
 - (2) Description of the Related Art including information disclosed under 37 CFR 1.97 and 37 CFR 1.98: A description of the related art

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known to the applicant and including, if applicable, references to specific related art and problems involved in the prior art which are solved by the applicant's invention. This item may also be titled "Background Art."

- (g) Brief Summary of the Invention: See MPEP § 608.01(d). A brief summary or general statement of the invention as set forth in 37 CFR 1.73. The summary is separate and distinct from the abstract and is directed toward the invention rather than the disclosure as a whole. The summary may point out the advantages of the invention or how it solves problems previously existent in the prior art (and preferably indicated in the Background of the Invention). In chemical cases it should point out in general terms the utility of the invention. If possible, the nature and gist of the invention or the inventive concept should be set forth. Objects of the invention should be treated briefly and only to the extent that they contribute to an understanding of the invention.
- (h) Brief Description of the Several Views of the Drawing(s): See MPEP § 608.01(f). A reference to and brief description of the drawing(s) as set forth in 37 CFR 1.74.
- (i) Detailed Description of the Invention: See MPEP § 608.01(g). A description of the preferred embodiment(s) of the invention as required in 37 CFR 1.71. The description should be as short and specific as is necessary to describe the invention adequately and accurately. Where elements or groups of elements, compounds, and processes, which are conventional and generally widely known in the field of the invention described and their exact nature or type is not necessary for an understanding and use of the invention by a person skilled in the art, they should not be described in detail. However, where particularly complicated subject matter is involved or where the elements, compounds, or processes may not be commonly or widely known in the field, the specification should refer to another patent or readily available publication which adequately describes the subject matter.
- (j) Claim or Claims: See 37 CFR 1.75 and MPEP § 608.01(m). The claim or claims must commence on separate sheet or electronic page (37 CFR 1.52(b)(3)). Where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation. There may be plural indentations to further segregate subcombinations or related steps. See 37 CFR 1.75 and MPEP § 608.01(i)-(p).
- (k) Abstract of the Disclosure: See MPEP § 608.01(f). A brief narrative of the disclosure as a whole in a single paragraph of 150 words or less commencing on a separate sheet following the claims. In an international

application which has entered the national stage (37 CFR 1.491(b)), the applicant need not submit an abstract commencing on a separate sheet if an abstract was published with the international application under PCT Article 21. The abstract that appears on the cover page of the pamphlet published by the International Bureau (IB) of the World Intellectual Property Organization (WIPO) is the abstract that will be used by the USPTO. See MPEP § 1893.03(e).

- (I) Sequence Listing. See 37 CFR 1.821-1.825 and MPEP §§ 2421-2431. The requirement for a sequence listing applies to all sequences disclosed in a given application, whether the sequences are claimed or not. See MPEP § 2421.02.

Drawings

New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because the figures themselves are devoid of content. There are only squares with references to the specification. The drawing do not in any way help to understand the claimed invention. Applicant is advised to employ the services of a competent patent draftsperson outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

Claim Objections

Claims 1-42 are objected to because of the following informalities: there are numerous grammatically errors throughout the claims. Examiner advises Applicant to carefully review the claims because of the many errors from translation of the parent

foreign application. Examiner had attempted to start listing the informalities but there are more than enough to simply advise Applicant to correct them.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 39-41 are rejected under 35 U.S.C. 101 as directed to non-statutory subject matter of software, per se. The claim lacks the necessary physical articles or objects to constitute a machine or manufacture within the meaning of 35 U.S.C. 101. It is clearly not a series of steps or acts to be a process nor is it a combination of chemical compounds to be a composition of matter. As such, they fail to fall within a statutory category. It is at best, function descriptive material per se. **Software must be stored on computer readable medium and executed by a computer to fall into a statutory category.**

Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." Both types of "descriptive material" are non-statutory when claimed as descriptive material per se, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive

material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994).

Merely claiming non-functional descriptive material, i.e., abstract ideas, stored on a computer-readable medium, in a computer, or on an electromagnetic carrier signal, does not make it statutory. See *Diehr*, 450 U.S. at 185-86, 209 USPQ at 8 (noting that the claims for an algorithm in *Benson* were unpatentable as abstract ideas because “[t]he sole practical application of the algorithm was in connection with the programming of a general purpose computer.”). See MPEP 2106.01 [R-6].

Furthermore claims 39-41 do not produce a useful, concrete, and tangible result. There is no physical transformation either. Data transformation is not a physical transformation. Claim 39 is directed to an abstract idea of having a computer program inside a device capable of memorizing identifiers. However, no function is actually being performed. Therefore no useful, concrete, and tangible result is produced. Claims 40 and 41 do not rectify these deficiencies and consequently are rejected for the same reasons above.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Again Examiner was began listing the many

problems with the claim's language and all of the problems concerning antecedence and improper references to parents claims but the task was simply too overwhelming. Examiner advises Applicant to carefully go through the claims and fix all of the many lack of antecedent basis problems. There are phrases present in the claims that are likely direct machine translations of the foreign parent applicant that do not definitively set the scope of the invention (i.e. on the fly, two distinct items, private flow). In practically ever dependent claim, references made to entities of parent claims are improper because they refer to the entities by a different name or phase. Appropriate correction is required.

Claim 21-23 should not have computer code in them. The codes renders the claim indefinite.

For purposes of examination, Examiner has tried to use the specification as a guide to what the intent of the claim are trying to define and set forth as the invention. Because of the many errors in language and antecedent basis, it was very difficult to understand what is being claimed. Furthermore, the claims in the present condition are interpretable in several ways. Again, Examiner uses the specification as a guide but is not incorporating limitations from the specification into the claims.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-42 are rejected under 35 U.S.C. 102(b) as being anticipated by USP 6,405,369, to Tsuria.

As per claim 1, Tsuria teaches a method for matching digital data reception equipment (2) with a plurality of external security modules (6, 8) each with a unique identifier (col. 3, lines 3-15), method characterized in that it comprises the following steps (col. 1, lines 54-65):

- connecting an external security module (6, 8) to the reception equipment (col. 1, lines 57-60),
- memorizing the unique identifier of the connected security module (6, 8) in the reception equipment (2), on the fly (col. 1, lines 61-65 and col. 3, lines 1-5).

As per claim 2, Tsuria teaches a check phase consisting of verifying whether or not the identifier of said module is memorized in reception equipment (2), every time that an external security module (6, 8) is connected to this reception equipment (2) later on (col. 3, lines 15-20).

As per claim 3, Tsuria teaches a step of transmitting a signal to the reception equipment (2) including at least one message to manage memorization of the identifier of the external security module (6, 8) and/or a check phase management message (col. 3, lines 20-35).

As per claim 4, Tsuria teaches at least one of the following set values: - authorize memorization, - prohibit memorization, - erase identifiers previously memorized in the reception equipment (2), - activate or deactivating the check phase (col. 3, lines 27-31).

As per claim 5, Tsuria teaches that said signal also includes the maximum allowable number of memorized identifiers (col. 9, lines 5-8).

As per claim 6, Tsuria teaches signal includes a reconfiguration set value through which an updated list of identifiers of external security modules (6, 8) matched with the reception equipment(2) is transmitted to said reception equipment (col. 7, lines 29-35).

As per claim 7, Tsuria teaches list is transmitted directly to the reception equipment (col. 6, lines 55-59).

As per claim 8, Tsuria teaches list is transmitted through an external security module (6, 8) connected to said reception equipment (col. 6, lines 40-45).

As per claim 9, Tsuria teaches check phase includes a procedure consisting of disturbing the data processing if the identifier of the connected external security module (6, 8) is not previously memorized in the reception equipment (col. 5, lines 10-15).

As per claim 10, Tsuria teaches data are distributed without encryption or scrambled by an encrypted control word and in that each external security module (6, 8) includes access rights to said data and a decryption algorithm for said control word (col. 5, line s35-40).

As per claim 11, Tsuria teaches said signal is transmitted to a reception equipment (2) in an EMM message specific to an 25 external security module (6, 8) associated with this reception equipment (col. 6, lines 55-60).

As per claim 12, Tsuria teaches a signal is transmitted to a reception equipment (2) in an EMM message specific to this reception equipment (col. 6, lines 55-60).

As per claim 13, Tsuria teaches a given reception equipment (2) said list is transmitted in an EMM message specific to a security module (6, 8) associated with this reception equipment (col. 6, lines 55-60).

As per claim 14, Tsuria teaches a signal is transmitted to a group of reception equipment (2) in an EMM message specific to a group of external security modules (6, 8) associated with said reception equipment (col. 6, lines 55-60).

As per claim 15, Tsuria teaches signal is transmitted to a group of reception equipment (2) in an EMM message specific to said group of reception equipment (col. 6, lines 55-60).

As per claim 16, Tsuria teaches a given group of reception equipment (2), said list is transmitted in an EMM message specific to a group of external security modules (6, 8) associated with said reception equipment (col. 6, lines 55-60).

As per claim 17, Tsuria teaches said check signal is transmitted in a private flow to a group of reception equipment (col. 6, lines 55-60).

As per claim 18, Tsuria teaches a given group of reception equipment (2), said list is transmitted in a private flow to each reception equipment (col. 6, lines 55-60).

As per claim 19, Tsuria teaches said private flow is processed by a dedicated software executable in each reception equipment as a function of the identifier of the external security module (6, 8) associated with it (col. 2, lines 51-54).

As per claim 20, Tsuria teaches a mechanism that prevents the use of an EMM transmitted to the same security module (6, 8) in two distinct items of reception equipment (col. 5, lines 15-20).

As per claims 21, 22, and 23, Tsuria teaches EMM are formatted to convey to the decoders and security card, which content is available to the particular subscriber and his equipment (col. 6, lines 55-60). The particular format is not a patentable limitation but rather a design choice.

As per claim 24, Tsuria teaches identifiers of external security modules (6, 8) are grouped in an encrypted list (col.2, lines 29-30).

As per claim 25, Tsuria teaches reception equipment (2) includes a decoder and the external security module (6, 8) includes an access control card (6) in which information about access rights of a subscriber to digital data distributed by an operator is memorized, and in that matching is done between said decoder and said card (6). (col. 2, lines 46-50).

As per claim 26, Tsuria teaches that the reception equipment (2) includes a decoder and the external security module (6, 8) includes a removable security interface (8) provided with a non-volatile memory that can cooperate firstly with the decoder, and secondly with a plurality of conditional access control cards (6) to manage access to digital data distributed by an operator, and in that matching is done between said decoder and said removable security interface (col. 1, lines 55-60 and col. 2, lines 45-55).

As per claim 27, Tsuria teaches the reception equipment (2) includes a decoder provided with a removable security interface (8) with a non-volatile memory that can cooperate firstly with said decoder, and secondly with a plurality of conditional access control cards (6), and in that matching is done between said removable security interface (8) and said access control cards (col. 2, lines 45-55).

As per claim 28, Tsuria teaches the data are audiovisual programs (col. 1, line 50).

As per claim 29, Tsuria teaches can be matched with a plurality of external security modules (6, 8) to manage access to digital data distributed by an operator, characterized in that it includes means of memorizing the identifier of 15 each external security module (6, 8) connected to it, on the fly (col. 1, lines 61-65 and col. 3, lines 1-5).

As per claim 30, Tsuria teaches it comprises a decoder and in that the external security module (6, 8) is an access control card (6) containing information about access rights of a subscriber to said digital data, matching being done between said decoder and said card (col. 2, lines 45-55).

As per claim 31, Tsuria teaches a decoder and in that the external security module (6, 8) is a removable security interface (8) provided with a non-volatile memory and that is designed to cooperate firstly with said decoder, and secondly with a plurality of conditional access control cards (6), to manage access to said digital data, matching being done between said decoder and said removable security interface (col. 1, lines 55-60 and col. 2, lines 45-55).

As per claim 32, Tsuria teaches a decoder provided with a removable security interface (8) with a non-volatile memory and that is designed to cooperate firstly with said decoder and secondly with a plurality of conditional access control cards (6) and in that matching is done between said removable security interface (8) and said access control cards (col. 2, lines 45-55).

As per claim 33, Tsuria teaches a plurality of external security modules (6, 8) to manage access to audiovisual programs distributed by an operator, each external security module (6, 8) having a unique identifier and including at least one data processing algorithm, decoder characterized in that it includes means of memorizing the identifier of each external security module (6, 8) connected to it, on the fly (col. 1, lines 61-65 and col. 3, lines 1-5).

As per claim 34, Tsuria teaches external security modules (6, 8) are access control cards (6) in which information about access rights of a subscriber to digital data distributed by an operator are stored (col. 2, line 38).

As per claim 35, Tsuria teaches external security modules (6, 8) are removable security interfaces (8) including a non-volatile memory that can cooperate firstly with the decoder and secondly with a plurality of conditional access control cards (6) to manage access to digital data distributed by an operator (col. 6, lines 52-60).

As per claim 36, Tsuria teaches a non-volatile memory and designed to cooperate firstly with a reception equipment (2), and secondly with a plurality of conditional access control cards (6), to manage access to digital data distributed by an operator, each card (6) having a unique identifier and containing information about

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access rights of a subscriber to said digital data, interface characterized in that it includes means of recording the identifier of each access control card (6) in said non-volatile memory, on the fly (col. 1, lines 61-65 and col. 3, lines 1-5).

As per claim 37, Tsuria teaches of a PCMCIA card on which digital data descrambling software is installed (col. 1, lines 10-15).

As per claim 38, Tsuria teaches consists of a software module (col. 6, lines 50-54).

As per claim 39, Tsuria teaches a reception equipment (2) that can cooperate with a plurality of external security modules (6, 8) each having a unique identifier and in which information about access rights of a subscriber to digital data distributed by an operator are stored, characterized in that it includes instructions to memorize the identifier of each external security module (6, 8) connected to said reception equipment (2), on the fly ((col. 1, lines 61-65 and col. 3, lines 1-5).

As per claim 40, Tsuria teaches instructions to locally generate matching control parameters of the reception equipment (2) with an external security module (6, 8) as a function of a signal transmitted to said reception equipment (2) by the operator (col. 6, lines 55-60).

As per claim 41, Tsuria teaches instructions intended to check if the identifier of said external security module (6, 8) is memorized in the reception equipment (2), at each later use of an external security module (6, 8) with the reception equipment (col. 3, lines 15-20).

As per claim 42, Tsuria teaches System including a plurality of reception equipment (2) connected to a data and/or services broadcasting network, each reception equipment (2) being capable of being matched with a plurality of external security modules (col. 1, lines 61-65 and col. 3, lines 1-5), said system also including a commercial management platform (1) communicating with the reception equipment (2) and with said external security modules (6, 8) characterized in that it also includes:

a first module arranged in said commercial management platform (1) and that will generate matching queries (col. 3, lines 15-20),

and a second security module arranged in said reception equipment (2) that will process said queries to prepare a matching configuration and to control 5 matching (col. 3, lines 20-35).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure is included on the PTO-892 form enclosed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL R. VAUGHAN whose telephone number is (571)270-7316. The examiner can normally be reached on Monday - Thursday, 7:30am - 5:00pm, EST.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on 571-272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. R. V./
Examiner, Art Unit 2431
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